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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,433	07/11/2001	Stephen L. Galbraith	043210-1396-00	8922

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EXAMINER

ROYAL, PAUL

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/903,433

Applicant(s)

GALBRAITH ET AL.

Examiner

Paul Royal

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 3,4,6-9 and 12-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. The indicated allowability of claims 11 and 17 is withdrawn in view of the reference(s) to Hanagan (US 4,095,820).
  
2. Applicant's arguments, filed 5 September 2003, with respect to the rejection(s) of claim(s) 1-2 and 10 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hanagan (US 4,095,820). The Examiner has, in light of applicant's arguments, applied the prior art of Hanagan more clearly and more accurately.
  
3. Note, applicant's argument that the "lower portion of the frame member (94) defines a luggage rack (110) that is supported above and out of contact with the mounting member (112)" is not persuasive because Hanagan does not teach the luggage rack is out of contact with the mounting member. Applicant should indicate where Hanagan supports applicant's position.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "backrest mounting member" improperly includes the term "mounting member", where "mounting member" is wholly recited as a separate element of the invention.

5. Claim 5 recites the limitation "backrest mounting portion" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. As best understood, the "backrest mounting portion" is the same as the backrest mounting member.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 5, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanagan (US 4,095,820).

Hanagan teaches a motorcycle comprising:

a frame (14);

a rear wheel (RW, See Examiner annotated Figure 1) rotatably interconnected with a rear portion of said frame and supporting a rear end of said motorcycle;

a mounting member (50) coupled to said frame (14), said mounting member (50) including a luggage rack mounting portion (LRMP, see Examiner annotated Figure 5), which extends rearwardly and having a top surface facing away from said frame, and a bottom surface facing toward said frame;

a seat (70) mounted over a portion of said top surface of said mounting member to sandwich a portion of said mounting member (50) between said seat (70) and said frame (14);

a luggage rack (110) mounted to said luggage rack mounting portion (LRMP) of said mounting member (50); and

wherein said mounting member (50) includes at least one side surface (SS, see Examiner's annotated Figure 5) and a backrest mounting member (BMM, see Examiner's annotated Figure 5) formed in said at least one side surface (SS), said motorcycle further comprising a backrest (BR, see examiner's annotated Figure 5) mounted to said backrest mounting portion (BMM).

wherein said luggage rack (110) extends rearwardly of said mounting member (50) in a generally cantilever fashion.

Note, while Hanagan, which only shows a partial view of the motorcycle, does not clearly teach a steering assembly pivotally mounted to the frame and a front wheel

rotatably mounted to said steering assembly and supporting a front end of said motorcycle, these components are inherent on a motorcycle.

For claim 5, note, as best understood, the "backrest mounting portion" is the same as the backrest mounting member.

***Allowable Subject Matter***

7. Claims 3-4, 6-9, 12-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not show a motorcycle as disclosed having the recited curvature, side surfaces, first and second arms, and stiffening ribs as claimed.

9. 17-20 are allowed.

10. The following is an examiner's statement of reasons for allowance:

For claim 17, the prior art does not show a motorcycle as disclosed having the seat pan portion as claimed.

For claims 18-20, the prior art does not show a motorcycle as disclosed having the Y shaped mounting member including the recited curvatures.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 703-308-8570. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Paul Royal  
Examiner  
Art Unit 3611

P. Royal  
November 12, 2003

  
**LESLEY D. MORRIS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**

